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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TADD E. VANYO, CRAIG D. HANSON, NEIL A. LAMBERT,
and MICHAEL F. PARENTEAU

Appeal 2009-007897
Application 10/849,511
Technology Center 2100

Before ST. JOHN COURTENAY III, THU A. DANG, and
CAROLYN D. THOMAS, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134(a) of the Examiner's final decision rejecting claims 1-21. We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

We Affirm-in-Part.

Invention

Appellants' invention relates generally to database management systems. More particularly, the invention on appeal is directed to providing access to database management systems via Internet user terminals using stored procedures. (Spec. 1, ll. 12-14).

Claim 1 is illustrative:

1. An apparatus comprising:
 - a. a user terminal which generates a user request;
 - b. a publicly accessible digital data communication network responsively coupled to said user terminal;
 - c. a legacy data base management system having access to at least one data base responsively coupled to said user terminal via said publicly accessible digital data communication network; and
 - d. a stored procedure having a sequence of command script statements responsively coupled to said legacy data base management system which is executed by said legacy data base management system in response to said user request.

The Examiner relies on the following prior art references as evidence of unpatentability:

Eastwick	US 6,240,417 B1	May 29, 2001
Vanyo	US 2005/0262157 A1	Nov. 24, 2005

Appellants appeal the following rejections:¹

1. Claims 1, 3, 8, 10, and 13-15 are provisionally rejected on the grounds of nonstatutory obviousness-type double patenting over claims 1, 3, 8, 10, 12, 14 and 15 of copending Application No. 10/849,473.
2. Claims 6, 7, 11, and 16 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.
3. Claims 1-21 stand rejected under 35 U.S.C. §102(b) as being anticipated by Eastwick.

Provisional Obviousness-type Double-Patenting Rejection

Claims 1, 3, 8, 10, and 13-15 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 3, 8, 10, 12, 14, and 15 of copending Application No. 10/849473 (Vanyo) and share common inventors and Assignees.² (Ans. 4).

Appellants have not presented any arguments in an effort to overcome this rejection. Arguments not made are considered waived. *See* 37 C.F.R. § 41.37(c)(1)(vii). *Cf. Ex Parte Moncla*, 95 USPQ2d 1884, 1885 (BPAI 2010) (precedential) (Holding that when all other rejections on appeal have been reversed and the only remaining rejection is a provisional non-statutory double patenting rejection, it was premature for the original Board panel to address the Examiner's provisional rejection of the claims.).

Accordingly, we summarily affirm the Examiner's provisional double-patenting rejection of claims 1, 3, 8, 10, and 13-15.

¹ The Examiner withdrew the §101 rejection of claims 16 and 21. (Ans. 16).

² Application No. 10/849,473 is awaiting a decision from the BPAI (Appeal No. 2010-003774).

Rejection of claims 6 and 7 under § 112, second paragraph

ISSUE

Did the Examiner err in concluding that claims 6 and 7 are indefinite under §112, second paragraph? (*See* App. Br. 8).

ANALYSIS

Regarding claims 6 and 7, the Examiner concludes it is unclear what item is being referenced by the clauses “said publicly accessible digital data base management system,” and “said command language script,” respectively. (Ans. 7).

Appellants respond that “though Appellants could have more artfully drafted [t]he phrase, it is not deemed indefinite as witnessed by the Examiner’s plurality of rejections without comment.” (App. Br. 16).

Regarding independent claim 6, we agree with the Examiner that “said publicly accessible digital data base management system” lacks proper antecedent basis as we conclude it is unclear how the phrase reasonably refers to “a publicly accessible digital data communication network,” as recited in claim 6. (underlined added). However, we conclude that “said command language script” of claim 7 has antecedent basis in the “command language scripted stored procedure” of claim 6, from which claim 7 depends.

Because we agree with the Examiner that at least claim 6 is indefinite, we conclude that claim 7 is also indefinite because it depends upon claim 6.

Therefore, we affirm the Examiner’s rejection of claims 6 and 7 under §112, second paragraph.

Rejection of claim 11 rejected under § 112, second paragraph

ISSUE

Did the Examiner err in concluding that claim 11 is indefinite because the Specification does not define the structures corresponding to each recited “means”?

PRINCIPLES OF LAW

The Court of Appeals for the Federal Circuit has provided the following guidance pertinent to the issue before us:

A patent applicant who employs means-plus-function language “must set forth in the specification an adequate disclosure showing what is meant by that language. If an applicant fails to set forth an adequate disclosure, the applicant has in effect failed to particularly point out and distinctly claim the invention as required by the second paragraph of section 112.” *In re Donaldson Co.*, 16 F.3d 1189, 1195 (Fed.Cir.1994) (en banc). To avoid purely functional claiming in cases involving computer-implemented inventions, we have “consistently required that the structure disclosed in the specification be more than simply a general purpose computer or microprocessor.” *Aristocrat Techs. Austl. Pty Ltd. v. Int'l Game Tech.*, 521 F.3d 1328, 1333 (Fed.Cir.2008).

“Because general purpose computers can be programmed to perform very different tasks in very different ways, simply disclosing a computer as the structure designated to perform a particular function does not limit the scope of the claim to ‘the corresponding structure, material, or acts’ that perform the function, as required by section 112 paragraph 6.” *Id.* “Thus, in a means-plus-function claim ‘in which the disclosed structure is a computer, or microprocessor, programmed to carry out an algorithm,

the disclosed structure is not the general purpose computer, but rather the special purpose computer programmed to perform the disclosed algorithm.’ ” *Id.* (quoting *WMS Gaming, Inc. v. Int'l Game Tech.*, 184 F.3d 1339, 1349 (Fed.Cir.1999)). Consequently, a means-plus-function claim element for which the only disclosed structure is a general purpose computer is invalid if the specification fails to disclose an algorithm for performing the claimed function. *See id.* at 1337-38.

Net MoneyIN, Inc. v. VeriSign, Inc. 545 F.3d 1359, 1367 (Fed. Cir. 2008).

FINDINGS OF FACT

1. The present Specification and drawings describe a “user terminal” (CLIENT) in Fig. 1, ref. 12, and page 11, ll. 10-15. The user terminal corresponds to the “permitting means” recited in claim 11.

ANALYSIS

Regarding claim 11, the Examiner contends that the claim is vague and indefinite because the body of the claim recites the limitations of “means for...” which has been reasonably construed as an attempt by Appellants to invoke 35 U.S.C. 112, sixth paragraph. In particular, the Examiner contends that the instant disclosure does not define the corresponding structures necessary for each recited “means.” (Ans. 7).

Appellants respond that the present Appeal Brief (p. 11) contains a mapping of each means-plus-function limitation of claim 11 to the Specification and drawings within the Summary of the Invention. (App. Br. 16).

We consider the portions of the Specification that correspond to the claimed “permitting means” as indicated by the Appellants in footnote 14 on page 11 of the Brief (FF 1). We note that “a means-plus-function claim element for which the only disclosed structure is a general purpose computer is invalid if the specification fails to disclose an algorithm for performing the claimed function.” *Aristocrat*, 521 F.3d at 1337-38. Because Appellants have not pointed to the corresponding algorithm for at least the claimed “permitting means” that corresponds to a client user terminal (FF 1) (a general purpose computer), we agree with the Examiner that claim 11 is indefinite under §112, second paragraph.

Accordingly, we affirm the Examiner’s rejection of claim 11 under 35 U.S.C. §112, second paragraph.

Rejection of claim 16 under § 112, second paragraph

ISSUE

Did the Examiner err in concluding that claim 16 is indefinite?

ANALYSIS

The Examiner contends that it is unclear what item should be improved as is referenced by “The improvement comprising:” language recited within the preamble clause of claim 16. (Ans. 8).

Appellants respond that claim 16 is not indefinite because it is merely a Jepson-type claim described under 37 C.F.R. §1.75(e). (App. Br. 17).

We agree with Appellants.

A Jepson claim is a method or product claim where one or more limitations are specifically identified as a point of novelty, distinguishable over at least the contents of the preamble. *Ex parte Jepson*, 243 Off. Gaz. Pat. Off. 525 (Ass't Comm'r Pat. 1917).

In the present case, the admitted prior art (what is being improved upon) is recited in the preamble before the phrase “The improvement comprising.” (Claim 16). Therefore, we conclude that claim 16 is a proper Jepson-type claim under 37 C.F.R. 1.75(e)(2), and is not indefinite under §112, second paragraph.³ Accordingly, we reverse the Examiner’s rejection of claim 16 under 35 U.S.C. §112, second paragraph.

§102 Rejection

ISSUE

Based upon our review of the administrative record, we have determined that the following issue is dispositive in this appeal regarding the anticipation rejection of claims 1-21:

³ See 37 C.F.R. 1.75 (e): “Where the nature of the case admits, as in the case of an improvement, any independent claim should contain in the following order:

- (1) A preamble comprising a general description of all the elements or steps of the claimed combination which are conventional or known,
- (2) A phrase such as "wherein the improvement comprises," and
- (3) Those elements, steps, and/or relationships which constitute that portion of the claimed combination which the applicant considers as the new or improved portion.”

Under §102, did the Examiner err in determining that Eastwick discloses the claimed “stored procedure” within the meaning of independent claims 1, 6, 11, 16, and 21?

FINDINGS OF FACT

2. Appellants’ disclosure describes a “stored procedure” as “essentially software programs scripted in the command language of the data base management system which may be defined and later initialized and executed upon a subsequent occasion.” (Spec. 5, ll. 7-9).

3. Eastwick discloses that the database integrator 314 is a part of the workstation 102. (Figs. 1 and 3).

4. Eastwick discloses that the legacy database management system 215 is a part of the host 104. (Figs. 1 and 2).

5. Eastwick discloses that “memory 302 contains a client program 312, a database integrator 314 of an exemplary embodiment, a terminal emulator, 316, and a navigator program 318. (Col. 4, ll. 27-29) (emphasis added).

ANALYSIS

As a matter of claim construction, we note that the term “stored procedure” is described by Appellants as “essentially software programs scripted in the command language of the data base management system which may be defined and later initialized and executed upon a subsequent occasion.” (FF 2).

Absent an express intent to impart novel meaning to a claim term, the words take on the ordinary and customary meanings attributed to them by those of ordinary skill in the art. *Brookhill-Wilk, LLC v. Intuitive Surgical, Inc.* 334 F.3d 1294, 1298 (Fed. Cir. 2003)

Here, we agree with Appellants that the term “stored procedure” should be broadly but reasonably construed in a manner consistent with the ordinary and customary meaning of this recognized term of art. (See App. Br. 20).

Our initial review of the Eastwick reference finds no literal disclosure of the claimed term of art “stored procedure.” However, this alone is not dispositive, because anticipation “is not an ‘ipsissimis verbis’ test.” *In re Bond*, 910 F.2d 831, 832-33 (Fed. Cir. 1990) (citation omitted). “An anticipatory reference . . . need not duplicate word for word what is in the claims.” *Standard Havens Prods., Inc., v. Gencor Indus., Inc.*, 953 F.2d 1360, 1369 (Fed. Cir. 1991).

Nevertheless, we agree with Appellants contention that all of the independent claims recite that the “stored procedure” is either executed by and/or stored within the legacy database management system. (App. Br. 20)(emphasis in original).

The Examiner maps the claimed stored procedure to the database integrator 314 of Eastwick. (Ans. 10). However, we find that Eastwick discloses that database integrator 314 is not a part of, and therefore not stored within, the legacy database management system (215), as would be required to meet the language of independent claims 6, 11, and 16. (See FF 3-5).

Regarding claims 1 and 21 that more broadly recited “coupled to” language, the Examiner contends that Eastwick discloses “a stored procedure . . . coupled to said legacy database management system . . . and executed . . . in response to said user request” with a database integrator. (Ans. 17). However, we find the claimed “stored procedure” is distinguishable from Eastwick’s database integrator 314 in that the function calls of the database integrator are invoked within memory 302 of workstation 101, rather than being “executed by said legacy database” (215) (FF 3-5), as would be required to meet the argued language of independent claim 1.

Regarding claim 21, we observe that the Examiner relies on the rejection of claim 1 to reject claim 21. (Ans. 14). However, as argued by Appellants (App. Br. 35), claim 21 recites additional limitations that are not recited in claim 1. We note that the allocation of burdens requires that the USPTO produce the factual basis for its rejection of an application under 35 U.S.C. §§ 102 and 103. *In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984) (citing *In re Warner*, 379 F.2d 1011, 1016 (CCPA 1967)). The one who bears the initial burden of presenting a prima facie case of unpatentability is the Examiner. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). Here, because claim 21 recites additional limitations that have not been addressed by the Examiner, we agree with Appellants that the Examiner has not established a proper prima facie case of anticipation regarding the rejection of claim 21.

Therefore, for essentially the same reasons argued by Appellants, we reverse the Examiner’s anticipation rejection of each independent claim on appeal. Because we have reversed the Examiner’s anticipation rejection of

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each independent claim, we also reverse the Examiner's anticipation rejection for each associated dependent claim.

DECISION

We affirm the provisional nonstatutory obviousness-type double patenting rejection of claims 1, 3, 8, 10, and 13-15 over claims 1, 3, 8, 10, 12, 14 and 15 of copending Application No. 10/849,473 (Vanyo).

We affirm the 35 U.S.C. § 112, second paragraph, rejection of claims 6, 7, and 11.

We reverse the 35 U.S.C. § 112, second paragraph, rejection of claim 16.

We reverse the 35 U.S.C. §102(b) rejection of claims 1-21.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

ORDER

AFFIRMED IN PART

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